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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/681,478	04/13/2001	Kun Zhang	GEMS8081.063	7337

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EXAMINER

TRAN, TONGOC

ART UNIT	PAPER NUMBER
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2134

DATE MAILED: 05/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/681,478

Applicant(s)

ZHANG ET AL.

Examiner

Tongoc Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 April 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This office action is in response to applicants application serial no. 09681,478 filed on 4/31/2001.

Information Disclosure Statement

2. The information disclosure statement (IDS) submitted on 5/18/2001 and 2/28/2002 has been considered by the examiner.

Double Patenting

3. Claims 1, 11, 18 and 22 of this application conflict with claims all of independent claims of Application No. 09/681,480, 09/681481 and 09/681,483. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 6, 8-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Rive (U.S. Patent No. 6,301,666).

In respect to claim 1, Rive discloses a method to permit indefinite use of an inactivated option resident on a device comprising the steps of:

receiving, at a centralized facility, a request from a user for indefinite use of an option resident on a device located remotely from the centralized facility (see col. 1, lines 55-67 and col. 2, lines 9-12);

determining whether to grant indefinite use of the option in response to the request based on whether a set of criteria has been satisfied (see col. 2, lines 1-8);

generating an activation key configured to permit indefinite use of the option in response to an indefinite use grant; transmitting the activation key from the centralized facility to the device; and automatically enabling user access to the option resident on the device in response to reception of the activation key (see col. 15, lines 40-57 and col. 17, lines 38-55).

In respect to claim 2, Rive discloses the method of claim 1 wherein the activation key is an alphanumeric identification code (see col. 17, lines 38-55).

In respect to claim 3, Rive discloses the method of claim 2 wherein the activation key is self-executing to automatically enable the option and further comprises the step of writing the alphanumeric identification code to memory of the device (see co. 15, lines 45-48).

In respect to claim 8, Rive discloses the method of claim 1 further comprising the steps of: generating a status of a customer;

denying the request if the customer status is unqualified; and
granting the request if the customer status is qualified (see col. 17, lines 7-26).

In respect to claim 9, Rive discloses the method of claim 8 wherein an unqualified customer status includes one of a delinquent account, an exhausted line of credit, a poor credit history, and incomplete educational requirements (see col. 17, lines 7-26).

In respect to claim 10, Rive discloses the method of claim 1 further comprising the step of generating an alphanumeric key specific to at least one of a user identifier, a system identifier, an indefinite user identifier, and an option identifier (see col. 17, lines 52-55).

In respect to claim 11, the claim limitation is a system claim that is substantially similar to method claim 1. Therefore, claim 11 is rejected based on the similar rationale.

In respect to claim 13, The system of claim 11 wherein the access code granting recurrent use is transmitted through one of a private communication system and a public communication system (see col. 17, lines 38-42).

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In respect to claim 14, the claim limitation is a system claim that is substantially similar to method claim 10. Therefore claim 14 is rejected based on the similar rationale.

In respect to claim 15, Rive discloses the system of claim 12 wherein the computer within the receiving center is further programmed to: determine if a software application upgrade is available for the at least one software application for which recurrent use has been requested; and notify the user of the availability to upgrade the requested software application (see col. 15, line 57-col. 16, line 12).

In respect to claim 17, the claim limitation is a system claim that is substantially similar to method claim 8. Therefore claim 17 is rejected based on the similar rationale.

In respect to claim 18, the claim limitation is a computer program claim that is substantially similar to method claim 1. Therefore, claim 18 is rejected based on the similar rationale.

In respect to claims 19 and 21, the claim limitations are computer program claim that are substantially similar to method claim 8. Therefore, claims 19 and 21 are rejected based on the similar rationale.

In respect to claims 22-23, 25 and 27, the claim limitations are substantially similar to method claims 1, 4 and 8-9. Therefore claims 22-23, 25 and 27 are rejected based on the similar rationale.

In respect to claims 24 and 26, the claim limitations are substantially similar to claims 20-21. Therefore, claims 24 and 26 are rejected based on the similar rationale.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rive (U.S. Patent No. 6,301,666).

In respect to claim 4, Rive discloses the method of claim 1. Rive does not explicitly disclose comprising the step of granting indefinite access to the option resident in memory of a medical imaging device. However, remote control access to medical device is old and well known. It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Rive to enabling medical device such as medical imaging device for cost effective.

In respect to claim 16, the claim limitation is a system claim that is substantially similar to method claim 4. Therefore, claim 16 is rejected based on the similar rationale.

6. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rive (U.S. Patent No. 6,301,666) in view of Mi et al. (U.S. Patent No. 6,523,067, hereinafter Mi).

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In respect to claims 5-6, Rive discloses the method of claim 1 comprising the step of determining satisfaction of the set of criteria including:

validating a user identifier; determining an option identifier; and determining an indefinite use request identifier (see col. 1, line 55-col. 2, line 12 and col. 17, lines 7-26, validating user and determining which pre-installed application and means of request, i.e. email, fax...are inherent). Rive does not disclose validating a system identifier. However, Mi discloses validating a system identifier to authenticate user (see col. 1, line 55-col. 2, line 5). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Rive's remotely enabling of preinstall software with the teaching of Mi's validating a system identifier for authentication for better security to prevent from password sharing (Mi, col. 1, lines 45-50).

In respect to claim 6, Rive discloses the method of claim 5 further comprising the step of denying the request for indefinite use if the user identifier is invalid (see Rive, col. 17, lines 37-55).

In respect to claim 7, Rive discloses the method of claim 5 further comprising the step of denying the request for indefinite use if the system identifier is invalid (see Mi, col. 1, line 55-col. 2, line 5).

In respect to claim 12, the claim limitation is a system claim that is substantially similar to method claim 5. Therefore, claim 12 is rejected based on the similar rationale.

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7. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rive (U.S. Patent No. 6,301,666) in view of Lahtinen (WO 99/250086).

In respect to claim 20, Rive discloses the computer program of claim 18. Rive discloses transmit the alphanumeric password to the device over a private communication (see col. Col. 17, lines 38-42) but Rive does not disclose further causing the computer to:

Generate an alphanumeric software key specific to the system identifier. However, Lahtinen discloses generating a software key using subscriber identify module of a mobile station (see Lahtinen, page 2, 4th paragraph). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the teaching of remotely enabling pre-installed software application with Lahtinen's teaching of generating a software key specific to the system identifier for better security because of variable value of encryption key (Lahtinen, page 1, lines 35-37).

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

-Sherman et al. disclose a method and system for embedded, automated, component level control of computer systems and other complex systems.

-Sherman et al. disclose a method and system for embedded automated component level control of computer system and other complex system.

-De la Huerga discloses a security badge for automated access control and secure data gathering.

Burd et al. Disclose systems and methods for remote monitoring and modulation of medical devices.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tongoc Tran whose telephone number is (703) 305-7690. The examiner can normally be reached on 8:30-5:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory A. Morse can be reached on (703) 308-4789. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Examiner: Tongoc Tran
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TT
April 16, 2004


GREGORY MORSE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100

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